

### **REMARKS/ARGUMENTS**

Reexamination and reconsideration of this application as amended is requested. By this amendment, Claims 1, 3, 6, 8, 13, and 17 have been amended. After this amendment, Claims 1-20 remain pending in this application.

(1) The Examiner objected to the disclosure because of informalities. Specifically, the Examiner requested that the Cross-Reference to Related Applications section be updated with current U.S. patent numbers.

Applicant has amended the Specification to comply with Examiner's requirements in the objection. Accordingly, Applicant requests that the Examiner withdraw the objection.

### **Claim Rejections - Double Patenting**

(2-3) The Examiner rejected Claims 8-9, 11-14 and 16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over some claims of Boivie et al. (U.S. Patent No. 6,625,773) in view of Hardjono (U.S. Patent No. 6,587,943).

The Examiner indicated in the Office Action that a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.

The Applicant is filing a terminal disclaimer herewith (see attached paper). In view of the filing of the terminal disclaimer herewith, the Applicant believes that the Examiner's rejection has been overcome. Therefore, the Examiner's rejection of Claims 8-9, 11-14 and 16, under the judicially created doctrine of obviousness-type double patenting, should be withdrawn.

### **Claim Rejections - 35 USC § 103**

(4-5) The Examiner rejected Claims 1, 3, 6, 8, 10, 13-15 and 17-19, under 35 U.S.C. 103(a) as being unpatentable over Haggerty et al. (U.S. Patent 6,331,983) in view of Hardjono (U.S. Patent 6,643,773).

Applicant has amended independent Claims 1, 3, 6, 8, 13, and 17, to more clearly and distinctly recite the present invention. Amended Claim 1 more clearly and distinctly recites that the user is the sender of the mail message and that the mail message is sent in a multicast packet including a list of destination addresses. Amended Claims 3, 6, 8, 13, and 17, to more clearly and distinctly recite that the mail message is in a multicast packet including a list of destination addresses. Support for the amendments to the claim language is found in the specification as originally filed. See for example on page 3, lines 8 to 12, and on page 5, lines 2 to 4. No new matter was added.

Applicant, first of all, wishes to point out that conventional multicast is receiver oriented, while the presently claimed multicast enabled email system and method is sender oriented. This is a significant difference. That is, the sender of a mail message creates the message and the list of destination addresses and initiates the sending of the mail message via a multicast packet including the list of destination addresses, according to the new and novel claimed aspects of the present invention. Conventional multicast, on the other hand, involves user recipients adding themselves (as subscribers) to multicast groups for reception of multicast packets delivering information that is typically distributed by a multicast server to the multicast group.

The Examiner characterized Hagerty as not teaching the distribution of electronic mail message across the network using multicast. Additionally, note that Hagerty specifically teaches using a single group address in the multicast packet for all destinations. See, for example, the Abstract section. Please note this single group address

is different than the presently claimed "list of destination addresses" in the multicast packet. Additionally, Hagerty teaches user receivers joining multicast groups to receive multicast group packets. This is very different than the presently claimed sender oriented electronic mail system and method. Amended Claim 1, for example, recites that the user is the sender of the mail message and that the mail message is sent in a multicast packet including a list of destination addresses. Note that, according to the present invention, the sender of the email composes the mail message and selects the destinations (and destination addresses) to go with the multicast packet.

Hardjono mentions that an example of multicasting entails transmitting an e-mail message to a plurality of users that each are on a mailing list. See the Background of the Invention section, column 1, lines 15-17. However, Hardjono does not teach how this would be done. Also, Hardjono does not teach or suggest the new and novel method and system for multicast mail, as recited for the presently claimed invention. Note that multicast, as used by Hardjono (and by Hagerty) is receiver initiated. See, for example, Hardjono, column 4, lines 17-42, and column 6, lines 13-27, where it discusses a member of the group configuring an authorized members list on a network device and on the computer system utilized by the various authorized members. This list is updated when a new user is added to the multicast and when a user logs off of the multicast. Each authorized member may notify the initiator that they are to participate in the multicast at a specified time.

On the other hand, in accordance with the presently claimed invention, the user is the sender of the mail message and the mail message is sent in a multicast packet including a list of destination addresses. Additionally, at an intermediate node on the network, a determination is made as to the "next hop" for the packet for each destination address of the list of destination addresses in the multicast packet. This multicast enabled electronic mail system and method is very different from that taught by Haggerty, by Hardjono, or by any combination of the two cited references.

Accordingly, in view of the amendments and remarks above, since neither Haggerty, Hardjono, nor any combination of the two cited references, teaches, anticipates, or suggests, the presently claimed invention, as recited for Claims 1, 3, 6, 8, 10, 13-15 and 17-19, Applicant believes that the rejection of Claims 1, 3, 6, 8, 10, 13-15 and 17-19, under 35 U.S.C. 103(a) has been overcome. The Examiner should withdraw the rejection of these claim.

(6) The Examiner rejected Claims 2, 4, 7, 9 and 12 under 35 U.S.C. 103(a) as being unpatentable over Haggerty et al. (U.S. Patent 6,331,983) in view of Hardjono (U.S. Patent 6,643,773) and further in view of Boivie et al., "Small Group Multicast: A New Solution for Multicasting on the Internet," IEEE, May-June 2000 (Hereinafter, "SGM"). The Examiner arguably combined the teachings of the SGM reference with the Hagerty and Hardjono teachings to attempt to obviate specifically using a reliable small group multicast technique, as recited for Claims 2, 4, 7, 9, and 12.

Applicant has amended independent Claims 1, 3, 6, and 8, to more clearly and distinctly recite the present invention. Amended Claim 1, and accordingly dependent Claim 2 that depends from Claim 1, more clearly and distinctly recites that the user is the sender of the mail message and that the mail message is sent in a multicast packet including a list of destination addresses. Amended Claims 3, 6, and 8, and accordingly dependent Claims 4, 7, 9, and 12, that depend respectively from amended independent Claims 3, 6, and 8, more clearly and distinctly recite that the mail message is in a multicast packet including a list of destination addresses. Support for the amendments to the claim language is found in the specification as originally filed. See for example on page 3, lines 8 to 12, and on page 5, lines 2 to 4. No new matter was added.

As has already been discussed above in numbered section (4-5) with respect to the rejection of amended Claims 1, 3, 6, and 8, based on the teachings of the Hagerty reference in view of the Hardjono reference, neither cited reference nor any combination thereof teaches, anticipates, or suggests, the presently claimed sender oriented electronic

mail system and method where the user is the sender of the mail message and that the mail message is sent in a multicast packet including a list of destination addresses. Note that multicast, as taught by Hardjono (and by Hagerty) is receiver initiated. Also, Hagerty specifically teaches using a single group address in the multicast packet for all destinations.

The SGM reference does not address electronic mail. It specifically discusses IP multicasting and small group multicasting where users can join multicast groups. However, it does not in any way teach or suggest, using multicast for an electronic mail system, especially as recited for the presently claimed invention. Note that electronic mail does not use IP multicasting because in electronic mail the set of destinations is determined by the sender while in traditional IP multicast, groups are determined by the receivers, i.e., the receivers that join the multicast groups.

Therefore, in view of the amendments and remarks above, since neither Hagerty, Hardjono, the SGM reference, nor any combination of the three cited references, teaches, anticipates, or suggests, the presently claimed sender oriented electronic mail system and method where the user is the sender of the mail message and the mail message is sent in a multicast packet including a list of destination addresses, Applicant believes that the rejection of Claims 2, 4, 7, 9 and 12, under 35 U.S.C. 103(a) has been overcome. The Examiner should withdraw the rejection of these claim.

(7) The Examiner rejected Claims 5, 11, 16 and 20, under 35 U.S.C. 103(a) as being unpatentable over Haggerty et al. (U.S. Patent 6,331,983) in view of Hardjono (U.S. Patent 6,643,773) and further in view of Provino et al. (U.S. Patent No. 6,269,085). The Examiner arguably combined the teachings of the Provino reference with the Hagerty and Hardjono teachings to attempt to obviate specifically using ACKS, NACKs, and retransmissions of multicast packets, as recited for Claims 5, 11, 16 and 20.

Applicant has amended independent Claims 3, 8, 13, and 17, to more clearly and

distinctly recite the present invention. Amended Claims 3, 8, 13, and 17, more clearly and distinctly recite that the mail message is in a multicast packet including a list of destination addresses. Amended Claims 8, 13, and 17, include the feature of determining one or more “next hops” corresponding to the list of destination addresses in the multicast packet. Support for the amendments to the claim language is found in the specification as originally filed. See for example on page 3, lines 8 to 12, and on page 5, lines 2 to 4. No new matter was added.

As has already been discussed above in numbered section (4-5), neither the Hagerty reference, nor the Hardjono reference, nor any combination thereof, teaches, anticipates, or suggests, the presently claimed sender oriented electronic mail system and method where the mail message is sent in a multicast packet including a list of destination addresses. Additionally, neither reference nor any combination thereof teaches or suggests a determination being made as to one or more “next hops” for the multicast packet corresponding to the list of destination addresses in the multicast packet. Note that multicast, as taught by Hardjono (and by Hagerty) is receiver initiated. Also, Hagerty specifically teaches using a single group address in the multicast packet for all destinations.

The Provino reference does not address electronic mail. It specifically discusses receiver oriented multicasting using ACKS, NACKS, and retransmission, to report progress of data reception by receivers and intermediate nodes. However, it does not in any way teach or suggest, using multicast for an electronic mail system, especially as recited for the presently claimed invention. Provino does not teach or suggest the presently claimed invention as recited for dependent Claims 5, 11, 16 and 20.

Since neither Hagerty, Hardjono, nor Provino, nor any combination of the cited references, teaches or suggests the presently claimed invention, as recited for the amended independent Claims 3, 8, 13, and 17, Applicant believes that these claims are allowable. Dependent Claims 5, 11, 16, and 20, respectively depend from amended independent

Claims 3, 8, 13, and 17, and, since dependent claims recite all of the limitations of the independent claim, it is believed that, therefore, Claims 5, 11, 16, and 20, also recite in allowable form.

Therefore, in view of the amendments and remarks above, since neither Hagerty, Hardjono, the Provino reference, nor any combination of the three cited references, teaches, anticipates, or suggests, the presently claimed sender oriented electronic mail system and method where the mail message is sent in a multicast packet including a list of destination addresses, and further where a determination is made as to one or more "next hops" for the multicast packet corresponding to the list of destination addresses, Applicant believes that the rejection of Claims 5, 11, 16, and 20, under 35 U.S.C. 103(a) has been overcome. The Examiner should withdraw the rejection of these claim.

### **Conclusion**

The foregoing is submitted as full and complete response to the Official Action mailed January 20, 2004, and it is submitted that Claims 1-20 are in condition for allowance. Reconsideration of the rejection is requested. Allowance of Claims 1-20 is earnestly solicited.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Applicant acknowledges the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §§ 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine

of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and his attorneys.

The present application, after entry of this amendment, comprises twenty (20) claims, including six (6) independent claims. Applicant has previously paid for twenty (20) claims including six (6) independent claims. Applicant, therefore, believes that an additional fee for claims amendment is currently not due.

However, a petition for a two month extension of time to file this response has been attached to this response with amendment. The Commissioner is hereby authorized to charge the fee (\$420) to Deposit Account 50-1556.

**If the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, or that in any way it would help expedite the prosecution of the patent application, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.**


The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account 50-1556.



In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

Respectfully submitted,

Date: 6/21/04

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